

**REMARKS**

Included herein is a request for a two-month extension of time along with the appropriate fee.

In the Office Action mailed 1/17/2006, Claims 9, 10 and 18 were rejected under 35 U.S.C. §112 as being indefinite. Claims 1, 2 and 18 were rejected as being anticipated under 35 U.S.C. §102(b). Claims 9 and 10 were rejected as being obvious over the prior art under 35 U.S.C. §103(a).

Claims 3 – 8 and 11-17 were objected to as being dependent upon a rejected base claim, but were otherwise indicated as being allowable.

In response, Applicant has herein canceled Claim 3. Amendments have been made to Claims 1-2, 9-10 and 18 in view of the Examiner's comments. In their currently form, Applicant now respectfully asserts that the Examiner's objections and rejections have been overcome, and the application is in form for allowance.

Specifically, the contents of Claim 3 (which was indicated as being allowable) have been added to Independent Claim 1, from which Claims 2 – 8 depend. Claims 9 and 10 were amended in order to overcome the Examiner's §112 rejections and further to clearly distinguish them from the prior art. Claim 18 has been amended to overcome the §112 rejection and to further distinguish it from the prior art.

**Venza, U.S. Patent No. 5,299,337**

Venza is a "Portable Beach Lounge and Method." The Venza lounge can be converted from a rectangular-shaped container into a wedge-shaped "lounge" when desired. The Venza lounge has a "canopy assembly" that is pivotally attached to the side of the

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“container.” There Venza “lounge” does not have a seat back, but rather is a sloped or wedge-shaped against which “a person can lean against and rest.”

**Byers, U.S. Patent No. 5,240,020**

Byers is a “Retractable Fisherman’s Shade and Method for Operating.” Byers has a folding “shading device,” but there is no related seat or cooler container associated with, or attached to the shading device.

**E.A. Howe, U.S. Patent No. 1,256,902**

Howe is a “chair.” The Howe chair is essentially a foldable chair that has a “shade” that is mounted upon a “spring roller” so that can be alternatively rolled up or extended to provide shade to the person seated on the chair. Howe does not have a cooler container associated with it.

The amendments to Claim 1 (and therefore claims 2 and 4-8) render these claims non-anticipated by virtue of the contents of allowed claim 3 being incorporated therein. The added content to Claim 18 recites a structure that is not taught by Venza because Venza teaches a chair that does not have a distinct seat back and seat bottom, but rather is a wedge-shaped cushion.

By combining the elements of various well-known decisions, one can see that a prima facie case of anticipation is established only when the Examiner provides:

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1. a single reference<sup>1</sup>
2. that teaches or enables<sup>2</sup>
3. each of the claimed elements (arranged as in the claim)<sup>3</sup>
4. expressly or inherently<sup>4</sup>
5. as interpreted by one of ordinary skill in the art.<sup>5</sup>

If the Examiner fails to produce a prima facie case of unpatentability, "then without more the applicant is entitled to the grant of the patent."<sup>6</sup>

Here, since Venza fails to each of the elements of Claims 1, 2, and 18, as amended, either expressly or inherently, the prima facie case of anticipation has not been made and these grounds for rejection must be withdrawn.

Similarly, Claims 9 and 10, as amended, recite seat structure that is distinct from the Venza seat. Neither Byers nor Howe disclose or hint at a combination of a cooler, a seat and an awning; the elements are therefore not disclosed by these references, either alone or in combination. Furthermore, it is unclear why the Examiner has concluded that it is obvious to even have combined these references. As is well settled, one critical element of the prima facie case of obviousness is a suggestion to combine or modify these references. Here, the Examiner has failed to provide any reason, suggestion, or motivation from the prior art as

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<sup>1</sup> *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

<sup>2</sup> *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

<sup>3</sup> *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

<sup>4</sup> *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

<sup>5</sup> *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

<sup>6</sup> *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

a whole for the person of ordinary skill to have combined or modified the reference(s), this suggestion must be analyzed at the time that the invention was made, and not in hindsight. Here, no such suggestion exists, and as such, the standard for rejection has not been met by the Examiner,<sup>7</sup> and these claims must be allowed

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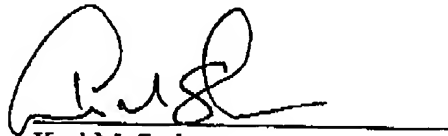
<sup>7</sup> See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Karl M. Steins', is written over a horizontal line.

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